

REMARKS

Claims 1, 2, 4, 6-13, 15, 17-20, 23, 25, 27, 30-33, 35 and 36 are currently pending in the present application. Claims 35 and 36 have been added as new claims.

In view of the present amendments and the following remarks, applicants respectfully request reconsideration and withdrawal of the rejections set forth in the Office Action and allowance of the pending claims.

Interview Summary

Applicants wish to thank Examiner Weis for the courtesy of a telephone interview conducted on Wednesday, August 5, 2009. Participating on behalf of the applicants were Michael Dukes (Reg. No. 59,878) and the undersigned representative. During the interview, the participants discussed the rejections raised against the present application under 35 U.S.C. §§ 101, 103 and the references cited in the Office Action. While no agreement on allowable subject matter was achieved during the interview, applicants have taken account the dialogue conducted during the interview in connection with preparing the present response.

Claim Rejections under 35 U.S.C. § 101

Claims 1-4, 6-13, 15, 17, 18, and 31-34 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully submit that the present amendments address the rejections under this section by confirming that the claimed subject matter is at least tied to a particular machine, if not also resulting in transformation of an

underlying article, as required under the *Bilski* test. Applicants therefore request reconsideration and withdrawal of the rejections maintained under this section.

Claim Rejections under 35 U.S.C. § 103(a)

The Patent and Trademark Office updated the MPEP in view of the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), to include guidelines for determining obviousness under 35 U.S.C. §103 ("Guidelines"). The Guidelines provided that the steps set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), should be followed when considering obviousness. See MPEP § 2141(II). The four factual inquiries used in *Graham* for determining obviousness include:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the Examiner must evaluate the evidence. See MPEP § 2141.

As noted in MPEP § 706.02(j) (entitled “Contents of a 35 U.S.C. 103 Rejection”):

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Also, as stated in MPEP § 2142, entitled “Legal Concept of Prima Facie Obviousness”:

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. . . The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.

....

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.

Also, as noted in MPEP § 2143.01 (entitled, “Suggestion or Motivation To Modify the References”):

IV. MERE STATEMENT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO

ESTABLISH PRIMA FACIE OBVIOUSNESS - A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE - If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE - If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Office bears the initial burden of factually supporting any rejection based on obviousness. If the Office does not establish a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

For at least the following reasons, applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness against the pending claims, as amended, because the cited references, either individually or collectively, fail to teach or suggest every element recited in the amended claims as described in more detail below.

Claims 1-4, 6-13, 15, 17-20, 23, 25, 27 and 30-34 stand rejected as obvious in view of a proposed combination of McCoy (U.S. Pat. No. 5,649,116) and Simmons (U.S. Pat. No. 5,093,787).

Applicants submit that neither McCoy nor Simmons teaches, suggests or discloses, among other elements, “determining [with said overdraft application] a chronic overdraft occurrence designation for said client in response to: (i) multiple overdraft occurrences occurring within the same predetermined time period, and (ii) a predetermined dollar amount associated with the multiple overdraft occurrences” as recited in Claim 1, for example. Unlike the various embodiments of the presently claimed invention, McCoy does not address chronic overdraft conditions or how financial institutions can undertake to address such chronic conditions.

Attention is invited to the specification of the present application at paragraphs [0047] to [0051], which details certain embodiments of the present invention that address chronic overdraft conditions occasioned by clients of a financial institution. Either alone or in combination, McCoy and Simmons do not disclose or suggest “determining a chronic overdraft occurrence designation” or making such a determination “in response to: (i) multiple overdraft occurrences occurring within the same predetermined time period, and (ii) a predetermined

dollar amount associated with the multiple overdraft occurrences” as recited in Claim 1 of the present application.

Accordingly, applicants submit that a *prima facie* case of obviousness has not been established with regard to Claim 1. In addition, independent Claims 19, 23, and 31-33 are likewise allowable for reasons substantially analogous to Claim 1. The pending dependent claims are allowable at least by virtue of their dependency from allowable independent claims. Applicants therefore submit that the Office Action has failed to establish a *prima facie* case of obviousness with regard to the currently pending claims.

Reservation of Arguments

Applicants do not concede the correctness of the Office’s rejections with respect to any of the independent or dependent claims and hereby reserve the right to make additional arguments as may be necessary because the independent and dependent claims include additional features that further distinguish the claims from the cited references, taken alone or in combination. A detailed discussion of these differences is believed to be unnecessary at this time in view of the fundamental differences pointed out above.

The present amendments are made without prejudice or disclaimer to the subject matter of the claims as originally filed. Furthermore, applicants do not acquiesce or otherwise concede the correctness of the rejections to the previously presented claims. Accordingly, applicants hereby reserve the right to pursue the subject matter of the claims as previously presented or as originally filed in the application in related applications that may be currently on file or filed at a later date. Moreover, applicants reserve the right to submit in such related

applications arguments made in connection with the present application. The present amendments are made to expedite prosecution of the application.

CONCLUSION

In view of the foregoing amendments and remarks, applicants request favorable reconsideration and allowance of the pending claims of the application and the issuance.

Should the examiner believe that one or more of the pending claims are not in condition for allowance, applicants respectfully request a telephone interview to discuss the Examiner's questions or concerns prior to issuance of a further Office Action.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Lazzara', is written over a horizontal line.

Michael D. Lazzara
Reg. No. 41,142

K&L Gates LLP
Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222-2312

Telephone: (412) 355-8994
Fax: (412) 355-6501
E-mail: michael.lazzara@klgates.com